

REMARKS

The above amendment cancels claims 2, 3, and 20. The outstanding Office Action includes no prior art-based rejections. Accordingly, it is understood that once the rejections under 35 U.S.C. §112 have been addressed, the application will be allowed.

The outstanding Office Action includes a rejection of claims 1-3, 6-15, 18, 20, 26-28, 31-35 and 38 under 35 U.S.C. §112, first paragraph for failing to provide an enabling disclosure. This rejection is traversed.

The outstanding Office Action recognizes that the specification teaches that a polymer comprising the repeating units of Formula I can be used in heat-activatable adhesives and pressure-sensitive adhesives. This is certainly correct. The Examiner's attention is directed to the specification at, for example, page 1, lines 4-6, page 5, lines 5-10, and page 8, lines 24-34. It is submitted that an application does not lack enablement by describing both heat-activatable adhesives and pressure sensitive adhesives.

Claim 1 is directed at an adhesive composition that contains a silicone-free polyurea-based polymer and a tackifier. The silicone-free polyurea-based polymer is characterized as a copolymer comprising repeating units of Formula I. The tackifier is provided in an amount to provide the adhesive composition as a pressure sensitive adhesive and in an amount less than about 45 parts by weight tackifier per hundred parts by weight polyurea-based polymer. Clearly, the specification supports claiming a pressure sensitive adhesive. The disclosure in the specification of heat-activatable adhesives does not detract from the disclosure of pressure sensitive adhesives. Furthermore, the specification at page 8, lines 26-33, describes the differences between pressure sensitive adhesives and heat-activatable adhesives. According to this portion of the specification, pressure sensitive adhesives "of the invention have the following properties at room temperature: (1) aggressive and permanent, (2) adherence with no more than finger pressure, (3) sufficient ability to hold onto an adherend, and (4) sufficient cohesive strength to be removed cleanly from the adherend." Heat-activatable adhesives "are substantially non-tacky at room temperature, but become tacky upon heating." Clearly, one having ordinary skill in the art would understand the differences between a pressure sensitive adhesive and a heat-activatable adhesive in view of the specification at page 8, lines 26-33.

In view of the above comments, the presently pending claims directed at a pressure sensitive adhesive are clearly supported and enabled by the specification of the above-identified patent application. If the Examiner persists in rejecting the claims as being non-enabled by the specification, the Examiner is requested to more clearly state the feature of the invention that is missing from the specification that results in the lack of enablement.

In view of the above comments, withdrawal of the rejection under 35 U.S.C. §112, first paragraph, is requested.

Claims 1-3, 6-15, 18, 20, 26-28, 31-35 and 38 stand rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. This rejection is traversed.

The outstanding Office Action states that "there must be critical parameters for said polyurea copolymer in order to become a PSA, not a heat-activatable adhesive." The Examiner's attention is directed at the specification at page 8, lines 26-33, describing the definitions of pressure sensitive adhesives and heat-activatable adhesives. According to the specification at page 8, lines 32-33, "Heat-activatable systems, unlike PSA systems, rely on a combination of pressure and/or heat to bond to a surface." According to the definition of pressure-sensitive adhesives at page 8, lines 26-30, pressure sensitive adhesives "of the invention have the following properties at room temperature: (1) aggressive and permanent tack, (2) adherence with no more than finger pressure, (3) sufficient ability to hold onto an adherend, and (4) sufficient cohesive strength to be removed cleanly from the adherend." According to the specification at page 8, lines 31-32, heat-activatable adhesives "are substantially non-tacky at room temperature, but become tacky upon heating." Clearly, a difference between pressure sensitive adhesives and heat-activatable adhesives is that heat-activatable adhesives require heating whereas pressure-sensitive adhesives do not.

The Examiner's attention is additionally directed to the specification at page 16, line 25 through page 17, line 2. In particular, at page 16, lines 26-27, the specification states that "tackifiers may be used to render the polyurea-based polymer pressure-sensitive." Clearly, the specification describes how to make an adhesive composition containing the polyurea-based polymer formula I pressure sensitive by the addition of tackifier. In fact, claim 1 provides that

the tackifier is present "in an amount sufficient to provide the adhesive composition as a pressure sensitive adhesive and in an amount less than about 45 parts by weight tackifier per 100 parts by weight polyurea-based polymer."

In view of the above comments, the present specification sufficiently describes the claimed adhesive composition. Accordingly, withdrawal of the rejection under 35 U.S.C. §112, first paragraph, is requested.

Claims 1-3, 6-15, 18, 20, 26-28, 31-35 and 38 stand rejected under 35 U.S.C. §112, second paragraph. This rejection is traversed.

The outstanding Office Action objects to the use of the word "based" in the phrase "polyurea-based polymer." The specification clearly describes what is meant by a polyurea-based polymer. The Examiner's attention is directed to the specification at page 9, line 25 through page 10, line 4. In particular, the specification provides that "polyurea-based polymers of the invention are segmented copolymers comprising a substantial portion of urea linkages in the backbone of the polymer." See the specification at page 9, lines 26-27. The specification at page 11, lines 10-16, additionally describe that a urea group results from a reaction of an isocyanate group and an amine group. Furthermore, the segmented copolymer having repeating units of formula I in claim 1 clearly includes urea groups. One having ordinary skill in the art would understand what is meant by the phrase "polyurea-based polymer" in claim 1 in view of the definition in the specification.

The outstanding Office Action objects to claim 20. It is pointed out that claim 20 has been cancelled by the above amendment.

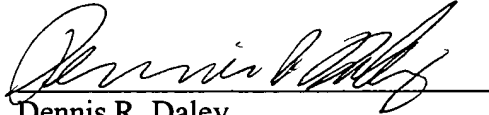
In view of the above comments, it is submitted that the claims are not indefinite, and withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is requested.

It is believed that the claims are in condition for allowance. Early notice to this effect is earnestly solicited.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: March 26, 2004

A handwritten signature in black ink, appearing to read "Dennis R. Daley", written over a horizontal line.

Dennis R. Daley
Reg. No. 34,994
DRD:PLSdb